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IP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/248,158	02/09/99	YUAN	Z 342312000600

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755 PAGE MILL ROAD
PALO ALTO CA 94304-1018

HM12/0524

EXAMINER

GARCIA, M

ART UNIT	PAPER NUMBER
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1627

10

DATE MAILED:

05/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File Copy

Office Action Summary

Application No.

09/248,158

Applicant(s)

Yuan et al

Examiner

Maurie E. Garcia, Ph. D.

Group Art Unit

1627

☒ Responsive to communication(s) filed on Feb 22, 2000☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim☒ Claim(s) 1-28 is/are pending in the applicatOf the above, claim(s) 11-18 and 20-28 is/are withdrawn from consideration☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-10 and 19 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6 & 7☒ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

DETAILED ACTION

Election/Restriction

1. As a result of a telephone conversation with Madeline Johnston on February 9, 2000, the species of Subgroup 1 from the previous Office Action were changed slightly to be in line with the language set forth in instant claim 3. The subgroup is set forth below for completeness of the record and should replace the previous recitation of Subgroup 1 as set forth in the Restriction Requirement mailed January 19, 2000 (in paragraph 6 under Group I). See also attached Interview Summary.

Subgroup 1: Molecular-property based binding interaction

- a. charge-charge
- b. charge-dipole
- c. dipole-dipole
- d. hydrophobic

2. Applicant's election without traverse of Group I in Paper No. 9 (filed February 22, 2000) is acknowledged. Applicant's election without traverse of the species of charge-charge interactions from the modified Subgroup 1 (see above) and kinase catalyzed reactions from Subgroup 2 is also acknowledged.

3. However, after review of the instant case, the examiner has decided to rejoin the species in Subgroup 1. The Restriction between Groups I and II and species election in Subgroup 2 still stands.

4. Therefore, claims 21-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Claims 11-18 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to non-elected species. Election was made without traverse in Paper No. 9. Claims 1-10 and 19 are examined on the merits.

Sequence Compliance

5. Applicant was asked in the previous action to comply with the Sequence Rules. The examiner is not aware of any papers being filed to comply; therefore, applicant is asked again to file such papers (see attached Notice To Comply). This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention..

A. The term “generally” in claim 1 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what the metes and bounds of “generally not stimulated” would be (i.e. how “not stimulated” is “generally not stimulated?”).

B. The terminology “distinct from” in claim 2 is a relative phrase which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Again, the metes and bounds of “distinct from” are unclear (i.e. how is the distinction determined?).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1, 3, 5, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlenoff (US 5,466,930; Ref. No. 8 on PTO-1449).

Schlenoff teaches “a scintillator for adsorbing and concentrating radioactive ions” that comprises a “solid scintillator and an ionic layer in the surface of and in contact with the solid scintillator” (see Abstract). The scintillating material is a doped plastic such as doped polystyrene (see column 3, lines 27-45 and column 4, lines 25-31). Either a negatively-charged layer or a positively-charged layer is formed on the surface of the scintillating material (see columns 5-6) and radioactive ions of opposite charge are adsorbed by this modified scintillating surface (see column 1, lines 17-32, column 6, lines 53-60 and the Example).

10. Claims 1-10 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kasila et al (US 5,972,595).

Kasila et al teach a method for measuring enzyme activity using a solid support coated with a hydrophobic layer (see column 2, lines 10-23). Specifically, the solid supports are 96-well FlashplatesTM (see definition, column 2, lines 48-50) coated with an artificial lipid layer in various ways (see, for example, column 4, lines 25-38 and column 5, line 63 through column 6, line 22). Enzyme substrates are bound via hydrophobic interactions within the lipid layer (column 3, lines 26-39). The biochemical transformation of the bound substrate causes a cleavage of a portion of the molecule, thus rendering it hydrophilic (see patented claims, especially claim 1). The hydrophilic portion is washed away, thus reducing the level of scintillation

(see, for example, column 5, lines 36-60). The assay of Kasila et al can be used to study various enzymes and is designed to study them in high-throughput fashion (column 6, lines 24-60).

Status of Claims

11. No claims are allowed.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 9:00 to 6:30.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

BENNETT CELSA
PRIMARY EXAMINER



Maurie E. Garcia, Ph.D.
May 19, 2000



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09/248158	2/9/99	Yuan, et al	342312000600

EXAMINER	
Maurie E. Garcia, Ph. D.	
ART UNIT	PAPER NUMBER
1627	

DATE MAILED:

Notice to Comply

Please find below a communication from the EXAMINER in charge of this application

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Any inquiry concerning this communication should be directed to Examiner **Maurie E. Garcia, Ph. D.**, Art Unit **1627**, whose telephone number is **(703) 308-0065**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

APPLICANT IS GIVEN A ONE MONTH EXTENDABLE PERIOD WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Applicant is requested to return a copy of the attached Notice to Comply with the response.

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: _____

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

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